

**REMARKS**

Claims 1-4, 6-10, 12-23, 25-30, 32-42, 44-47, 49-61, 63, 65-89, 91-100 are now present in connection with the present application, with claims 11, 31, 48 and 68 being canceled without prejudice or disclaimer of the subject matter contained therein.

**Amendments do not Raise Any New Issues**

In an effort to expedite prosecution, Applicants amended the independent claims to remove "semantically meaningful" from the claims (although Applicants do not necessarily agree with the Examiner). Further, each of the independent claims have been amended to include an indication that "the words and word chunks are in an agglutinated language". Such amendments do not raise any new issues requiring further consideration and/or search as this language was previously presented and considered in now cancelled claims 11, 31, 48 and 64. Thus, consideration and allowance of the amended claims is respectfully requested.

**Telephone Interview**

Again, Applicants wish to emphasize that a telephone interview with Examiner Spooner was conducted on Thursday, October 27, 2005. In the interview, Applicants' representative discussed the differences between the various two and three letter combinations set forth in the O'Dell publication and the "word chunks" claimed in the claims of the present application. Applicants' representative indicated that the claims would be revised to clarify this distinction. Specifically, Applicants' representative proposed several potential clarifying amendments, including amending the claims to clarify that the word chunks were semantically meaningful. Although no agreement was reached, the Examiner appeared to appreciate that the O'Dell publication, and its use of two letter or even three letter combinations which merely cumulatively added letters, did not utilize Applicants word chunks (taken alone or in combination with the Mickunas patent).

The Examiner apparently did not agree with Applicants amendment of “semantically meaningful” after reconsideration. However, as a difference was apparently recognized in the interview, **the present claims are again amended, this time to clarify that the words and word chunks are in an agglutinated language** (such as German, for example), to clearly differentiate the independent claims from the O'Dell publication, and its use of two letter or even three letter combinations in the English language.

### **Discussion of Example Embodiment Illustrating Word Chunking in an Agglutinated Language**

Some advantages of word chunking over basic letter-type word predictions are best explained in the context of **an agglutinating language, such as German for example**. Regarding the word “zeitungsausschnitt” for example, if one were to try basic word prediction, or even two or three letter prediction, the word would be located very slowly **after many key hits**. First, for at least four hits (or two with two letter combinations), the many words beginning with the chunk “zeit” would remain displayed. Thereafter, for the next three additional hits (or possibly fewer with some random letter combinations), the many more words beginning with the chunk “zeitung” would remain displayed. Thereafter, many more hits would likely be needed before “zeitungsausschnitt” was available for selection.

Instead, with the use of word chunks in an agglutinating language such as German for example, the word can be located efficiently by “chunking” through the word “zeitungsausschnitt” using word chunks. First, the semantically meaningful chunk “zeit” is displayed, and in response to selection thereof, “zeitung” can then be identified and selected as another semantically meaningful word chunk. From there, the word “zeitungsausschnitt” can quickly be displayed for selection in an efficient manner.

Such use of word chunking is therefore a unique and extremely useful way to efficiently predict desired words in an agglutinating language such as German, where many words are constantly compiled together to make

progressively larger words (thus making normal word prediction nearly impossible). Further, such chunking would not be nearly as useful in a non-agglutinating such as English, wherein very few words are made from other words.

**Claim Rejections Under 35 U.S.C. §112, second paragraph**

The Examiner rejects the claims, speculating that the claims are incorrect by referring to displaying words or word chunks in response to only selection of a word chunk (and not a word chunk or a word). However, the claims are correct as they now stand in that if a word is selected, the word chunking prediction has been completed for that word. It is situations where a word chunk is selected, wherein further chunks or words need remain selectable. As such, words in agglutinating languages can be easily chunked through until a desired word is displayed and selected.

For at least such reasons, the rejection is traversed and withdrawal of the rejection is requested.

**Claim Rejections Under 35 U.S.C. §112, first paragraph**

Although Applicants do not necessarily agree with the rejections, the rejections of the claims are rendered moot in view of the amending of the claims to remove the language “semantically meaningful”.

**Claim Rejections Under 35 U.S.C. §103**

The Examiner has rejected claims 1-3, 12, 20-22, 24, 32, 39-41, 43 and 49 under 35 U.S.C. §103 as being unpatenable over O'Dell in view of Mickunas (U.S. Patent No. 5,040,113), the Mickunas '113 patent. This rejection is rendered moot in view of the incorporation of the language of claim 11 into each of the independent claims.

**Claim Rejections Under 35 U.S.C. §102**

The Examiner has rejected claims 1-3, 12, 20-22, 24, 32, 39-41, 43 and 49 under 35 U.S.C. §102 as being unpatentable over O'Dell. This

rejection is respectfully traversed in that, based upon the Examiner's own admission above, the Mickunas '113 patent is needed in combination with O'Dell to reject even independent claim 1, let alone the dependent claims. If a combination rejection is needed under 35 U.S.C. §103, **then the Examiner is respectfully requested to withdraw the finality of the present office action and issue a new non-final office action.**

### **Claim Amendments**

Initially, each of the independent claims is amended to clarify that **the words and word chunks are in an agglutinated language** (such as German, for example), which is not taught or suggested by the alleged combination of the O'Dell publication in view of the Mickunas '113 patent, even assuming arguendo that they could be combined.

### **Even if Combined, Alleged Reference Combination fails to meet all of the Limitations of the Independent Claims**

#### **A. "...wherein the words and word chunks are in an agglutinated language"**

As indicated above with regard to claim 1 for example, and indeed with regard to each of the independent claims in connection with the present application, the O'Dell reference fails to teach or suggest at least the limitation of **"words and word chunks are in an agglutinated language"** (such as German, for example). Such examples of such chunks in an agglutinated language may include "zeit" and "zeitung" (used to predict the word "zeitungsausschnitt" of the German language, for example. Thus, in a language such as German for example, word chunks can be chosen to allow one to **"chunk through"** word prediction of lengthy words such as "zeitungsausschnitt", in such a highly agglutinating language such as German, in a highly efficient manner.

To the contrary, neither the O'Dell publication nor the Mickunas '113 patent, even assuming arguendo that they could be combined, teaches or suggests the use of **word chunks in an agglutinating language** as claimed. At best, the Mickunas '113 patent uses only letter by letter prediction in English and the O'Dell publication only teaches using some type of sequential multi-letter combinations in English or single characters in other languages, which are not designated to be **word chunks in an agglutinating language**, as claimed.

Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

**B. "...wherein a word chunk includes a predetermined identifier, identifying it as a word chunk"**

Further, Applicants note that the arguments set forth in all of the previous Amendments (the entire contents of which are incorporated herein) are maintained (noting that **neither reference does any "identifying" of a selectable word chunk**, for example )and thus, for these additional reasons, withdrawal of the rejection is requested.

**O'Dell**

With regard to each of the independent claims of the present application, these claims state that a word chunk includes a predetermined identifier, identifying it as a word chunk. **As admitted by the Examiner, at least such a limitation is not taught or suggested by O'Dell.**

As indicated above with regard to claim 1, and indeed with regard to each of the independent claims in connection with the present application, the O'Dell reference fails to teach or suggest at least the limitation of **"...a word chunk includes a predetermined identifier, identifying it as a word chunk"**. As one non-limiting example of such a predetermined identifier, such an identifier maybe a "tilde" symbol such as that shown in Fig. 4a of the present application. By using such easily identifiable and selectable word chunks, a user can quickly and easily find word chunks and

advance to desired words in a manner much quicker than known letter by letter word prediction systems. Although Applicants do not admit that the O'Dell reference meets other limitations of the various claims, including claim 1 for example, both Applicants and the Examiner agree that at least the aforementioned limitation of a word chunk including a predetermined identifier, identifying it as a word chunk, is a limitation which is not taught or suggested by O'Dell.

#### The Mickunas '113 Patent

The Mickunas '113 patent is directed to a method of manipulating data. The method relates to a method for programming a digital computer for automatically collecting, storing, organizing and displaying data inputted by the operator. A character which is entered is stored as a first character variable "x", and such a character is used to identify a pre-stored list of phrases based on the character entered and based upon another variable "USERSTG". See column 3, lines 46-61 for example. Thereafter, a next character may be entered and is stored as the character "y", wherein the phrase stored in "USERSTG" is extended by appending the characters stored in "y". Thereafter, additional phrases including the lengthened variable "USERSTG" is displayed, wherein selections can be made therefrom. The prefix "USERSTG" can be distinguished from the remaining phrases in the selection list by underlining any other method. See column 4, lines 18-43 for example.

#### Alleged Combination of O'Dell and the Mikunas '113 Patent

As previously indicated, the Examiner admits that O'Dell does not teach or suggest a word chunk including a predetermined identifier, identifying it as a word chunk. The Examiner alleges that Mikunas teaches this limitation, citing column 4, lines 18-29, wherein it is indicated that the prefix "USERSTG" can be distinguished from the remainder of phrases in the select list (SL) by underlining or any other method suitable for presentation. The Examiner alleges that it would have been obvious for one

of ordinary skill in the art to combine the teachings of O'Dell with the Mickunas '113 patent; and alleges that the motivation for doing so would have been to identify any prefix to the user which will have information concatenated upon in constructing a word (again citing column 4, lines 18-29 of the Mickunas '113 patent). Further, **the Examiner still essentially takes official notice** that would have been obvious to one of ordinary skill in the art to include as one of the possible predetermined identifiers as taught, including underlining in italics, to include a tilde as an identifier. Applicants respectfully traverse.

While Applicants do not necessarily dispute that an identifier may take many forms, including those other than a tilde, Applicants respectfully submit that the alleged combined teachings of the O'Dell reference and the Mickunas '113 patent would still not meet the claimed limitation of a word chunk including a predetermined identifier, identifying it as a word chunk. Specifically, the Mickunas '113 patent is directed to **highlighting or underlining that which was entered**, namely the prefix "USERSTG", which may include the first entered character "x" and the second entered character "y" for example. This particular entered set of letters is taught as being distinguished from other phrases in the selection list (SL)-see column 4, lines 18-24 for example. However, this does not identify any selectable word chunk, as claimed, **it only identifies, at best, an input portion of selectable words.** It does not and **cannot identify a word chunk as a word chunk.**

As stated above, the Examiner is alleging that O'Dell teaches word chunks, not the Mickunas '113 patent. The Mickunas '113 patent does not teach word chunks, thus it cannot teach or suggest "...a predetermined identifier, identifying it as a word chunk" as claimed, taken alone or in combination with O'Dell.

Thus, even if such a teaching could be combined with that of the O'Dell reference, which Applicants do not admit, such a teaching would still fail to makeup for the limitation as set forth in claim 1 for example, of a selectable word chunk, "wherein a word chunk includes a predetermined

identifier, identifying it as a word chunk". As stated above, as claimed, a word chunk is something that is selectable, such as the chunk "zeit" shown in the non-limiting example of Fig. 4a of the present application. To the contrary, the "USERSTG" is clearly a prefix that includes, in a word prediction fashion, the first or first two letters of a word.

Thus, even if it could be applied to the O'Dell patent, it would only teach, at best, underlining of an entered letter such as "w" in the list of two letter combinations such as wh, we, wi; or the underlining of two entered letters such as wh for example, in a display of three letter groupings such as whi, whe, who. Such an identifier **merely attaching to what has been entered, is not the same** as something which **identifies a word chunk as a word chunk**, instead of the selectable word for example. Accordingly, even assuming *arguendo* that the Mickunas '113 patent could be combined with the O'Dell reference, the teachings of the Mickunas '113 patent would still fail to teach or suggest anything with identifies a word chunk as a word chunk, instead of just a displayed selectable word for example.

Such a distinction is further clarified with reference to the non-limiting example of Fig. 4a. As shown in the exemplary format in Fig. 4a, the tilde identifies the selectable word chunks "zahn" and "zeit" as word chunks, differentiating them from selectable words such as "zeihen" and "zwischen". At least such an identifier, which identifies a word chunk as a word chunk as claimed in claim 1 for example, and as somewhat similarly claimed in each of the independent claims, is not taught or suggested by the alleged combination of the O'Dell and the Mickunas '113 patent, even assuming *arguendo* that they could be combined.

Accordingly, for at least such reasons, Applicants respectfully submit that independent claim 1, and indeed each of the independent claims of the present application, is patentable over the alleged combination of O'Dell and the Mickunas '113 patent, even assuming *arguendo* that they could be combined. Thus, withdrawal of the rejection is respectfully requested.



### **Lack of Motivation to Combine Reference Teachings**

The Examiner merely sets forth his opinion that it would have been obvious to combine the teachings of the O'Dell patent with those of the Mickunas '113 patent, alleging that it would have been obvious to identify any prefix to the user which will have information concatenated upon in constructing a word. The alleged motivation is not true for the reasons set forth in the previous Amendments (the entire contents of which are incorporated herein); and is further merely "opinion" set forth by the Examiner. As such, it **is not proper motivation** for combining the references. Thus, the Examiner has failed to establish a proper prima facie case of obviousness under 35 U.S.C. 103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. In re Dembiczak, 50 USPQ2d 1614 (Fed.Cir. 1999). The statements made by the Examiner have nothing to do with why someone would be lead to combine the letter by letter prediction system of O'Dell with the program system of the Mickunas '113 patent. **The systems are completely distinct and have nothing to do with one another.** The Examiner has not provided any reasons of the desirability of making the specific combination that was made by the applicant.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide **particular findings** as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. **Broad conclusory statements standing alone, such as those set forth by the Examiner, without evidentiary support in the references, are not "evidence"**. As such, they do not establish a prima facie case of obviousness under 35 U.S.C. §103(a).

In essence, the Examiner has used Applicants invention, in hindsight, as a blueprint. The Examiner's use of hindsight is clearly improper. The Examiner is not entitled to recognize deficiencies in prior art such as O'Dell, and then search only for the missing pieces of Applicants claim. **There is no reason set forth in the Mickunas '113 patent to highlight entered letters in a word prediction system such as in O'Dell.** The Examiner must separately find evidence of reasons for making such a combination, independent of Applicants invention. The Examiner gives only "opinion", not evidence. Without this "evidence" of motivation, a prima facie case of obviousness under 35 U.S.C. §103(a) has not been established. Thus, the rejection is inapplicable and should not be maintained.

Further, relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner **must provide** an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly, Applicants respectfully challenge the Examiner's use of opinion or personal knowledge, and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained. Accordingly, withdrawal of the rejection is requested.

### **Taking of Official Notice**

Further, Applicants object to the Examiner's taking of official notice that it would have been obvious to one of ordinary skill in the art to include, as one of the possible predetermined identifiers, a tilde. While Applicants do not necessarily dispute that the term identifier as claimed in claim 1 could include things other than a tilde, such as underlining or italics, Applicants respectfully **again challenge** the Examiner to find, in the prior art, the use of a tilde as an identifier in the context as claimed.

The Examiner has alleged that the teachings of the Mickunas '113 patent teach use of an identifier (although Applicants do not agree), but the Examiner still merely states that it would be obvious to replace the highlighting of the Mickunas '113 patent with the use of a tilde. **No such teaching or suggestion has been provided in any prior art reference and thus the Examiner is still merely providing an Official Notice argument.** Accordingly, Applicants **again challenge** the Examiner to find the use of a tilde as an identifier in the context as claimed.

### **Additional Claim Rejections Under 35 U.S.C. §103**

The Examiner has further rejected claims 6, 17, 19, 25, 36, 38, 44, 54 and 56 under 35 U.S.C. §103 as being unpatentable over O'Dell in view of Mickunas and further in view of Kadashevich et al. (the Kadashevich et al. '577 patent). This rejection is respectfully traversed.

Again, Applicants note that the independent claims have been amended and thus, for reasons previously set forth in the corresponding independent claims, Applicants respectfully request that the rejection be withdrawn. As previously stated, there are clearly deficiencies in the alleged combination of O'Dell in view of Mickunas regarding the newly amended independent claims, deficiencies which are not made up by the teachings or suggestions of the Kadashevich et al. patent, even assuming *arguendo* that they could be combined. Accordingly, withdrawal of the rejection is respectfully requested.

Further, regarding the alleged motivation for combining the references, Applicants respectfully suggest that proper motivation has not been provided and a prima facie case of obviousness has not been established. Thus, the combination of O'Dell in view of Mickunas and the Kadashevich et al. '577 patent is improper.

### **CONCLUSION**

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of

claims 1-4, 6-10, 12-23, 25-30, 32-42, 44-47, 49-61, 63, 65-89, 91-100 in connection with the present application is earnestly solicited.

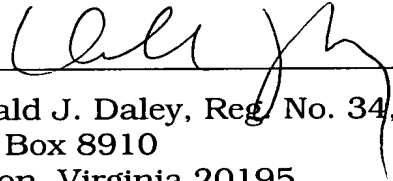
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for a one (1) month extension of time for filing a reply to the outstanding non-final Office Action and submit the required \$60.00 (small entity) extension fee herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY & PIERCE, P.L.C.

By   
Donald J. Daley, Reg. No. 34,313  
P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000

DJD: